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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/707,935	01/26/2004	Clay E. Clemmer	P-A830CIP	1934

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EXAMINER
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PARKER, FREDERICK JOHN

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 04/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/707,935		CLEMMER, CLAY E.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Frederick J. Parker		1762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/26/04</u> . | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### *Claim Objections*

1. Claim 1 is objected to because of the following informalities: (1) claim 1, a repeat of claim 2 is inadvertently incorporated into the end of claim 1, for examination anything beyond “set” on line 11 will be ignored. Please remove claim 2 from claim 1. Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1,5-7,10,14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claims 1,5,10,14 are vague and indefinite because independent claims 1 and 10 fail to recite a step “(c)”, so that the meaning of dependant claims 5 and 14 cannot be ascertained since a step critical to the dependant claims may be missing.
- Claims 1,6,10 are vague and indefinite because they recite the final coating to be applied in a “non-uniform manner” which is confusing, since it could mean applying a uniform layer in plural non-uniform steps; it could refer to non-uniformity of the product in pattern/ shape, in thickness, in color, etc.
- Claim 7 is vague and indefinite because the intended meaning of the “finishing” step is unclear.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by McKinnon US 5942072.

McKinnon teaches a method of making products simulating natural stone comprising the steps of ; preparing/ cleaning the substrate prior to coating, col. 6, 15-18, per claim 2; coating the substrate 10 with a first curable polymer layer 24 ( per claim 1/a); applying particulate material 26 onto the partially cured layer 24 (per claim 1/b); applying a second curable polymer layer 40 thereon which is ultimately non-uniform in shape (fig. 10 and thickness, col. 7, 46-47), per claim 1/d; applying a second particulate layer 46 thereon (per claim 1/e); and applying a polymeric sealer layer (per claim 4). Particulate material from layer 46 is removed, which inherently would have exposed porous surface per claim 3. Thus the reference teaches every method limitation of the claimed method as set forth.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over McKinnon.

McKinnon is cited for the same reasons previously discussed, which are incorporated herein.

Claim 6 teaches a flexible substrate. McKinnon teaches on col. 6, line 3, a “semi-rigid substrate” which one of ordinary skill would have interpreted to mean a substrate having some degree of flexibility, which is all that is required by claim 6 (a) since there is no requirement of the degree of flexibility required. Further 6 (a) requires “securing” the substrate. It is the Examiner’s position that such a step is present in McKinnon because the substrate is provided in such a way that it is successfully coated to form the product. Having an unsecured or moving substrate would not provide the product as disclosed. Furthermore, securing would have been an obvious step within the purview of one of ordinary skill for ease of coating reproducibility. It is well-established that the artisan is presumed to know something about the art apart from what the references disclose, *In re Jacoby* 135 USPQ 317; The conclusion of obviousness maybe made from “common sense” and “common knowledge” of the person of ordinary skill, *In re Bozek* 163 USPQ 545. McKinnon provides removal of tape to reveal indentations, applying additional materials and rolling (col. 8, 42-47), etc which would all be “finishing” steps. The steps of claims

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1 and 6 are otherwise analogous; claims 4 and 8 are the same limitations directed to separate dependant claims which are discussed in relation to the reference, above. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of McKinnon by utilizing non-rigid/flexible substrates as suggested by the disclosure and secured substrates because such modifications are suggested by the reference and obvious process variations within the purview of one of ordinary skill.

9. Claims 5,9 are rejected under 35 U.S.C. 103(a) as being unpatentable over McKinnon.

McKinnon is cited for the same reasons previously discussed, which are incorporated herein. The additional layers as claimed are not disclosed.

Although the Examiner cannot reasonably interpret with certainty where the additional set of layers is applied (see 35 USC 112 rejection above), it is the Examiner's position that application of plural sets of layers to achieve a desired aesthetic or decorative effect would have been within the purview of the skilled artisan, particularly in view of the suggestion of col. 8, 37-col. 9, 41 which stresses aesthetic/ decorative aspects of the product. Matters related to the choice of ornamentation producing no mechanical effect or advantage considered to constitute the invention are considered obvious and do not impart patentability, *In re Seid* 73 USPQ 431. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the process of McKinnon by applying plural sets of layers as taught by the reference in order to provide a desired decorative appearance simulating natural stone.

10. Claims 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over McKinnon in view of Hoppe et al US 3188296.

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McKinnon is cited for the same reasons previously discussed, which are incorporated herein.

Bubbling gas through an unset resin to form voids is not taught.

Hoppe et al teaches to prepare porous resinous plastics (same as McKinnon) by introducing air or other gas into the non-set formulation so that the gas bubbles become entrapped in the reaction mixture, and the final product contains cells or voids due to the gas bubbles.

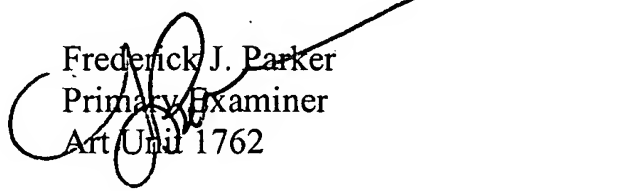
McKinnon's goal of producing multi-layer products comprising polyurethanes to resemble "natural stone, marble, granite, brick, or any other suitable product" would have reasonably suggested to the skilled artisan to form products simulating natural stone materials having porosity or vesicles (gas pockets in volcanic rocks), such as scoria, rhyolite, geyselite/ sinter, etc. Since Hoppe et al teaches forming voids/ gas bubbles in such polymeric materials prior to fully setting, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the process of McKinnon by incorporating the concept of pore forming in resinous materials set forth by Hoppe et al to form a product with voids to simulate porous natural stone materials such as scoria, rhyolite, geyselite, etc.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frederick J. Parker whose telephone number is 571/ 272-1426. The examiner can normally be reached on Mon-Thur. 6:15am -3:45pm, and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571/272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Frederick J. Parker  
Primary Examiner  
Art Unit 1762

fjp